

The Examiner objected to the numbering of claims as failing to accord 37 CFR 1.126, and has renumbered claims 17-18 as 16-17, respectively. Applicant appreciates the Examiner's renumbering, as applicant mistakenly thought that the Reissue application introduced twelve new claims (it introduced eleven).

The Examiner objected to the new abstract of the disclosure because in lines 6-8, the descriptive sentence was considered to be new matter. As discussed more fully below, applicant disagrees that the sentence is new matter because it reflects the detailed description in abstract form, just as it should. Nevertheless, this is a minor bone of contention and applicant herewith submits a new substitute abstract that omits the cited sentence.

The Examiner objected to the drawings under 37 CFR 1.83(a) for failing to show the invention specified in the claims, namely, the non-confidential printed data and printed interior. Accordingly, applicant submits herewith a drawing change request to add the non-confidential printed data and printed interior in abstract presentation (as suggested by the Examiner).

The Examiner noted that the last amendment filed by Applicant (dated July 6, 2001) inadvertently followed 37 C.F.R. 1.121(a) rather than 1.121(b). Applicant apologizes for the oversight. However, it appears that the changes were entered. In tracing back, it appears that all prior amendments were proper, and any subsequent ones surely will be. Although the Examiner and applicant informally discussed filing a substitute specification, applicant is restricted from this solution by rule. If the Examiner so desires, applicant will file a redline specification tracking all changes to date for his convenience.

The Examiner objected to the amendment filed November 13 (sic), 1997 during original prosecution under 35 U.S.C. 132 because it introduced new matter into the original disclosure. According to the Examiner, the added material which was not supported by the original disclosure is as follows: At column 2, line 17 of the specification, that the telephone rate information was to be provided in a list form. At column 2, line 18, that the instructions pertained specifically for use. At column 3, lines 49-52, that the printing can comprise a company logo. At column 4, lines 12-16, that the VMP was ever to be manufactured in the configuration of Figure 4 without the bottom perforated portion first existing.

Initially, applicant contends that this objection is of improper form in the context of this reissue proceeding. The amendment of November 13, 1997 has already been entered and appears in the issued patent, and applicant cannot change the amendment despite the Examiner's objection. However, applicant can change the present reissue application. Therefore, to the extent that the present reissue application incorporates the amendment filed November 13, 1997, then the examiner's objection should be directed to the reissue application, and applicant suggests that the crux of the Examiner's objection is that the reissue specification at page 10, lines 10-16 (which appears as a result of the proposed amendment filed September 24, 1997) is not supported by the original application. To the extent that this is the Examiner's intent, then applicant contends that page 10, lines 10-16 is not the result of "new matter" added by amendment.

First of all, the embodiment shown at the reissue specification at page 10, lines 10-16 was fully and adequately supported from the start, regardless of whether it was originally disclosed as an intermediate step or as a standalone embodiment. Either way, it was fully and fairly disclosed to the public. The "new packet invention" described throughout the original specification "permits the sales clerk to swipe the card through a magnetic reader to validate and register the PIN number, while still maintaining the integrity of the packet." Top and side perforations are clearly necessary to provide the quick-release feature from the folded cardstock. However, a bottom portion with bottom perforations is unnecessary toward the stated form or function of the invention. Indeed, one skilled in the art would readily recognize the obvious variants of this invention from a reading of the specification, and it has never been a patentee's burden to enumerate each and every variant. It is an applicant's burden to specifically describe one preferred embodiment, and then to claim the entire invention. That is exactly what Messrs. Sprague are trying to do in this case. Consequently, page 10, lines 10-16 is not the result of "new matter" added by amendment, and each and every feature therein was originally disclosed.

Further to the foregoing, the Federal Circuit has explained that the new matter prohibition is closely related to the adequate disclosure requirements of 35 U.S.C. Section

112. See, Pennwalt Corp. v. Akzona Inc., 740 F.2d 1573, 1578, 222 USPQ 833, 836 (Fed. Cir. 1984). Section 112, in turn, requires: "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art . . . to make and use the same." 35 U.S.C. Section 112 (1994) (emphasis added). Thus, to avoid the new matter prohibition, an applicant must show that its original application *supports* the amended matter. See, Kolmes v. World Fibers Corp., 107 F.3d 1534, 1539, 41 USPQ2d 1829, 1832 (Fed. Cir. 1997). In the present case, the issue is whether the "new packet invention" which "permits the sales clerk to swipe the card through a magnetic reader to validate and register the PIN number, while still maintaining the integrity of the packet." includes the intermediate step as shown in Fig. 4 (without bottom perforated portion) as well as the standalone embodiment of Fig. 3 (with bottom perforated portion). The standalone Fig. 4 embodiment was fully capable of being reduced to practice (i.e., no technological problems, the resolution of which would require more than ordinary skill and reasonable time) based on Fig. 4 as originally filed. Consequently, the amendment finds ample support in the original disclosure, and no new matter was added. In other words, the applicants were merely qualifying the true scope of their invention by said amendment, and were not describing new and/or additional features.¹ This case is similar to Schering Corp. v. Amgen Inc., 55 USPQ2d 1650 (Fed. Cir. 2000) in which the inventor amended his claims to substitute "IFN-(a)" for "leukocyte interferon" because the latter term had become outdated. The district court concluded that the terminology substitution violated the new matter prohibition. The Federal Circuit disagreed, holding that this was an unduly broad interpretation of "new matter." The Federal Circuit found that the new claim language merely renamed or recast the invention - "whatever its scope may have been at the time of application - in accordance with accepted scientific norms." In Schering, as here, an application may later be amended to recite the function, theory or advantage without introducing prohibited new

¹ This is evidenced by the substitute specification filed November 13, 1997, which was accompanied by applicants sworn statement that the substitute specification did not contain recitation new to the original disclosure.

matter. In re Reynolds, 443 F.2d 384, 170 USPQ 94 (CCPA 1971) (relationships clearly depicted in the drawings provided sufficient disclosure to support claims).

In addition to the foregoing, the material added by the amendment filed November 13, 1997 was inherently contained in the original application. See, Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1438, 221 USPQ 97, 106 (Fed. Cir. 1984). "Matter which is added that is deemed inherent in the original application is not considered new matter." Id. In the present case, the intermediate step as shown in Fig. 4 (without bottom perforated portion) is inherent to the standalone embodiment of Fig. 3 (with bottom perforated portion), and one skilled in the art would understand that the language added November 13, 1997 was added for clarification. The change was a natural change to clarify the scope of the invention, and such a correction would have been, to a person skilled in the art, "inherent in the original application." See, Litton Systems, 728 F.2d at 1438-39 [221 USPQ at 107]. Should the Examiner dispute the applicant's inherency argument, then the Examiner bears the burden of presenting *particular evidence or specific reasons* why persons skilled in the art would not recognize the inherency of the material added by the amendment filed November 13, 1997.

The Examiner objected to the amendment made July 6, 2001, due to the change to the Abstract in lines 6-8, which is said to constitute new matter. As discussed more fully above, applicant disagrees that the sentence is new matter because it was expressly and/or inherently supported by the original disclosure, and the new abstract merely reflects the detailed description in abstract form, just as it should. Again, this is a minor issue and applicant herewith submits a new substitute abstract that omits the cited sentence.

The Examiner again objected to the reissue oath/declaration filed with this application under 37 CFR 1.175(a)(1) and MPEP §1414 because it fails to specifically identify at least one error which is relied upon to support the reissue application. Similarly, claims 1-4 and 16-17 were rejected as being based upon a defective declaration under 35 U.S.C. 251. Accordingly, applicant submits a new and proper oath/declaration herewith which does specifically identify the error relied upon to support the reissue application.

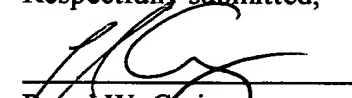
Applicant acknowledges and appreciates the Examiner's indication that the arguments

filed June 28 and July 6, 2001 have been found persuasive as to the construction of Figures 4-5 comprising a stand alone embodiment. Applicant contends that this is fully commensurate with the original disclosure filed August 9, 1996 for the reasons set forth above.

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In view of the above amendments and remarks, it is believed that this reissue application is now in condition for allowance, and such a Notice is respectfully requested.

Respectfully submitted,



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